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OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P.
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EXAMINER

KEYS, ROSALYND ANN

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte THOMAS OSTROWSKI, RAIMUND RUPPEL,
EVA BAUM, and KATHRIN HARRE

Appeal 2010-000697
Application 10/578,874
Technology Center 1600

Before DONALD E. ADAMS, LORA M. GREEN, and
STEPHEN WALSH, *Administrative Patent Judges*.

WALSH, *Administrative Patent Judge*.

DECISION ON APPEAL¹

This is an appeal under 35 U.S.C. § 134(a) involving claims to a process for the continuous production of polyether alcohols. The Patent Examiner rejected the claims on the ground of anticipation. We have jurisdiction under 35 U.S.C. § 6(b). We reverse.

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

STATEMENT OF THE CASE

Claims 1-11, which are all the pending claims, are on appeal. Claim 1 is representative and reads as follows:

1. A process for the continuous production of polyether alcohols by reaction of alkylene oxides with H-functional starter substances in the presence of DMC catalysts, which comprises, at the beginning of the process
 - a) firstly placing initial charge material and DMC catalyst in a reactor,
 - b) metering in alkylene oxide so that the metering rate which is maintained for continuous operation of the reactor is reached in a time of from 100 to 3 000 seconds,
 - c) metering in starter substance during or after step b) so that the metering rate which is maintained for continuous operation of the reactor is reached in a time of from 5 to 500 seconds,
 - d) after the fill level in the reactor which is desired for continuous operation of the reactor has been reached, taking off continuously from the reactor while at the same time metering in starter substance and alkylene oxides in such an amount that the fill level in the reactor remains constant and metering in DMC catalyst so that the catalyst concentration necessary for continuous operation of the reactor is maintained in the reactor.

The Examiner rejected claims 1-11 under 35 U.S.C. § 102(b) as anticipated by O'Connor et al., US 6,359,101 B1, issued Mar. 19, 2002.

ANTICIPATION

The Issue

The rejection states: "O'Conner [sic] et al. teach the instant invention (see entire disclosure, in particular column 6, lines 19-53; column 7, line 10 to column 15, line 48; note (3) under Table 3; and Table 6)." (Non-Final Rejection mailed Nov. 27, 2007, p. 3; Ans. 3.)

Appellants contend that the rejection did not satisfy the PTO's initial burden to establish the factual basis for rejection. (App. Br. 5.) According

to Appellants, the Examiner first “erred by not explaining the factual basis for the § 102 rejection,” purportedly “requiring Applicant to read the entire [O’Connor] disclosure and find some basis for the anticipation rejection.” (*Id.* at 6). Appellants next argue that the Examiner “erred in finding that O’Connor describes the invention claimed” (*id.*) because “A. O’Connor does not explicitly describe the claimed process” (*id.* at 5-13), and “B. O’Connor does not implicitly describe the claimed process” (*id.* at 13-16).

The issues with respect to this rejection are:

did the Examiner err by requiring Applicants to read the entire O’Connor disclosure and find some basis for the anticipation rejection;
did O’Connor explicitly describe the claimed process; and
did O’Connor implicitly describe the claimed process?

Findings of Fact

1. The O’Connor patent is entitled “Preparing Polyether Polyols With DMC Catalysts.” (O’Connor, title.)

2. O’Connor taught:

When compounds (i) to (viii) are used as first starter in a continuous process, a portion of them (i.e. usually less than 20% by weight of the total weight added) may be initially added with the DMC catalyst before continuously adding the epoxide and the remainder of the first starter. Additionally, after the polyol intermediate is formed, the compounds (i) to (viii) or conventional starter material may be added as second starters in order to form the desired polyether polyol.

(*Id.* at col. 10, ll. 30-38.)

3. O’Connor taught:

Additionally, this invention is an improvement over the patented ARCO continuous process technology. Using one or more active diols such as . . . the catalyst can be activated and

then additional DMC catalyst, propylene oxide, water or propylene glycol could be fed into the reactor continuously while product is continuously removed.

(*Id.* at col. 14, ll. 26-32.)

Principles of Law

To anticipate a claim, a prior art reference must disclose every limitation of the claimed invention, either explicitly or inherently. Anticipation is an issue of fact, and the question whether a claim limitation is inherent in a prior art reference is a factual issue.

In re Schreiber, 128 F.3d 1473, 1477 (Fed. Cir. 1997) (citations omitted).

Analysis

As to Appellants' first contention, the Examiner directed Appellants' attention to O' Connor's disclosure at "column 6, lines 19-53; column 7, line 10 to column 15, line 48; note (3) under Table 3; and Tables 1- 6." (Ans. 3.) We therefore cannot agree that the Examiner "requir[ed] Applicant to read the entire [O'Connor] disclosure and find some basis for the anticipation rejection," as Appellants contend. We are not persuaded of reversible error on that point. We next turn to whether the cited portions of the O'Connor disclosure were sufficient basis for the rejection.

We agree with Appellants that O'Connor did not explicitly describe the claimed invention. Claim 1 requires, among other things, that alkylene oxide be metered in so that its metering rate continuous operation be reached between 100 and 3,000 seconds, and that starter substance be metered in so that its metering rate continuous operation be reached between 5 and 500 seconds. O'Connor did not explicitly teach reaching those metering rates in those time ranges.

We also agree with Appellants that O'Connor did not implicitly or inherently describe the claimed invention. The Examiner found that one of skill in the art "would have a reasonable expectation that the data obtained in Tables 1-6 are applicable to batch as well as continuous processes," and "the 25 minutes . . . in Table 2 . . . would be applicable for both batch and continuous operation." (Ans. 6.) However the data in Tables 1-6 refer to batch process examples, not examples of a continuous process. A rejection based on § 102 requires evidence that a process was described, not an expectation that the description of a batch process would reasonably be expected to be applicable to a continuous process. Even if the Examiner's analysis of Table 6 (*id.* at 8) shows that the data and times describing several batch processes fall within the time ranges recited in claim 1, those descriptions of various batch processes are not a description of a continuous process using those parameters. Because O'Connor's description of batch processes was not a description of the claimed continuous process, we disagree that the evidence supports the Examiner's finding that "the claimed metering rates were inherently taught by O'Connor." (*Id.*)

CONCLUSIONS

The Examiner directed attention to specific portions of the O'Connor disclosure and did not err by requiring Applicants to read the entire O'Connor disclosure and find some basis for the anticipation rejection.

O'Connor did not explicitly describe the claimed continuous process that reaches metering rates within specific time periods.

O'Connor did not implicitly describe the claimed continuous process that reaches metering rates within specific time periods.

Appeal 2010-000697
Application 10/578,874

SUMMARY

We reverse the rejection of claims 1-11 under 35 U.S.C. § 102(b) as anticipated by O'Connor.

REVERSED

lp

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